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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,692	12/10/2001	Michael Patrick Lyons	P 280456 702176 REG	9882
909	7590	12/23/2003		
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			EXAMINER HAMILTON, ISAAC N	
			ART UNIT 3724	PAPER NUMBER

DATE MAILED: 12/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/007,692

Applicant(s)

LYONS ET AL.

Examiner

Isaac N Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-14 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-14 and 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Cancellation of claims 5 and 15-17 is acknowledged.

### *Specification*

2. Objections to the specification are hereby withdrawn.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-12 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsten in view of Wallis (4,774,865).

Regarding claims 1 and 18, note base 10; adjustable post 12; base-contacting surface juxtaposed base 10 and post 12; linear motion, first position and second position in a first direction in column 3, lines 21-48; first force applying mechanism 15, 22; impacting post 12'; impact position and elevated position in second direction is inherent in an alligator shear, column 3, line 58; second force applying mechanism also inherent in alligator shear; force applying element 15; first force applying device 22; cutting axis in figure 3 is a vertical line between impacting post 12' and adjustable post 12.

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Regarding claims 2 and 19, note flat upper surface juxtaposed between base 10 and post 12.

Regarding claim 3, note post 12 slides on base 10.

Regarding claims 4 and 20, note base-contacting surface is flat in figure 3 and slides horizontally on base 10.

Regarding claim 8, in an alligator shear it is inherent for the second force applying mechanism to be supported by the base.

Regarding claim 9, it is inherent in an alligator shear that the second force applying mechanism includes a pressure cylinder.

Regarding claims 10 and 11, note in figure 3 that the impacting post 12' moves vertically and the adjusting post moves horizontally.

Regarding claim 12, note first stop in figure 3. The top portion of base 10, which houses the force applying element 15 is the first stop.

Kirsten discloses everything as noted above, but does not disclose a pressure cylinder containing nitrogen. However, Wallis teaches pressure cylinder containing nitrogen 16. It would have been obvious to provide a pressure cylinder containing nitrogen in Kirsten as taught by Wallis in order to automate the force applying mechanism in Kirsten.

Regarding claims 7, 21, note first side on the right side of post 12 in figure 3, and second side on the left side of the post 12 in figure 3. Kirsten and Wallis disclose the claimed invention except for a second pressure cylinder. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second pressure cylinder, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in

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the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It would have been obvious to provide a second pressure cylinder in the combination of Kirsten and Wallis in order to have the ability to move the adjustable post in the case that one of the pressure cylinders fails during manufacturing operations.

5. Claims 13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsten and Wallis as described above and further in view of Mori (5,671,647). Kirsten and Wallis discloses everything as noted above, but does not disclose a second stop. However, Mori teaches second stop 15, 151. It would have been obvious to provide a second stop in Kirsten as taught by Mori in order to prevent damage to the adjustable post by restricting movement of the adjustable post into the path of the impacting post.

Regarding claim 22, note first side on the right side of post 12 in figure 3, and second side on the left side of the post 12 in figure 3. Kirsten and Wallis disclose the claimed invention except for a second pressure cylinder. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second pressure cylinder, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It would have been obvious to provide a second pressure cylinder in the combination of Kirsten and Wallis in order to have the ability to move the adjustable post in the case that one of the pressure cylinders fails during manufacturing operations.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kirsten and Wallis as applied to claim 13 above, and further in view of Graham (5,383,381). Kirsten discloses everything as noted above, but does not disclose a gib. However, Graham

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discloses gib 48. It would have been obvious to provide a gib in Kirsten as taught by Graham in order to prevent the adjustable post from sliding unevenly and jutting one end of the adjustable post into the path of the impacting post, thus creating damage to the adjustable post.

7. Claims 1-4, 8-12 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsten in view of Wallis and Chazen (3,645,159).

Regarding claims 1 and 18, note base 10; adjustable post 12; base-contacting surface juxtaposed base 10 and post 12; linear motion, first position and second position in a first direction in column3, lines 21-48; first force applying mechanism 15, 22; impacting post 12'; second force applying mechanism also inherent in alligator shear; force applying element 15; first force applying device 22; cutting axis in figure 3 is a vertical line between impacting post 12' and adjustable post 12.

Kirsten discloses everything as noted above, but does not disclose an impact position and does not disclose an elevated position. However, Chazen discloses an alligator shear that teaches impact position and elevated position in figure 1. It would have been obvious to provide an impact position and an elevated position in Kirsten as taught by Chazen in order to duplicate the motion required in an alligator shear.

Regarding claims 2 and 19, note flat upper surface juxtaposed between base 10 and post 12.

Regarding claim 3, note post 12 slides on base 10.

Regarding claims 4 and 20, note base-contacting surface is flat in figure 3 and slides horizontally on base 10.

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Regarding claims 8 and 9, note second force applying mechanism in column 2, lines 27, 28 in Chazen.

Regarding claims 10 and 11, note in figure 3 that the impacting post 12' moves vertically and the adjusting post moves horizontally.

Regarding claim 12, note first stop in figure 3. The top portion of base 10, which houses the force applying element 15 is the first stop.

The combination discloses everything as noted above, but does not disclose a pressure cylinder containing nitrogen. However, Wallis teaches pressure cylinder containing nitrogen 16. It would have been obvious to provide a pressure cylinder containing nitrogen in the combination as taught by Wallis in order to automate the force applying mechanism in Kirsten.

Regarding claim 7, note first side on the right side of post 12 in figure 3, and second side on the left side of the post 12 in figure 3. The combination and Wallis disclose the claimed invention except for a second pressure cylinder. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second pressure cylinder, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It would have been obvious to provide a second pressure cylinder in the combination of Kirsten and Wallis in order to have the ability to move the adjustable post in the case that one of the pressure cylinders fails during manufacturing operations.

8. Claims 13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kirsten, Wallis and Chazen as applied to claims 1-4, 8-12 and 18-21 above, and further in view of Mori (5,671,647). The combination discloses everything as noted above, but

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does not disclose a second stop. However, Mori teaches second stop 15, 151. It would have been obvious to provide a second stop in the combination as taught by Mori in order to prevent damage to the adjustable post by restricting movement of the adjustable post into the path of the impacting post.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kirsten, Wallis and Chazen as applied to claims 1-4, 8-12 and 18-21 above, and further in view of Graham (5,383,381). The combination discloses everything as noted above, but does not disclose a gib. However, Graham discloses gib 48. It would have been obvious to provide a gib in the combination as taught by Graham in order to prevent the adjustable post from sliding unevenly and jutting one end of the adjustable post into the path of the impacting post, thus creating damage to the adjustable post.

### ***Response to Arguments***

Applicant's arguments filed 09-26-2003 have been fully considered but they are not persuasive. Applicant asserts that the cylinder assembly 16 in Wallis is not structured for moving a post linearly between first and second cutting positions and securing the post from moving from a desired position during cutting. It is believed that Wallis does show this. Wallis discloses a pressure cylinder system that both move and lock an adjustable post. Note that in Wallis there is an adjustable post 15, which is moved in a direction when the cylinders are actuated. In figure 2 of Wallis piston 40 of the pressure cylinder is in an upper, locked position. In figure 3 of Wallis piston 40 of the pressure cylinder is in a lower, locked position. Wallis teaches a pressure cylinder containing nitrogen that is structured to move an adjustable post



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between first and second cutting positions and structured to lock the adjustable post from moving from the desired position.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is well known to replace old manual mechanisms with new technology. In Kirsten an old screw assembly is used to position the adjustable post. Wallis teaches the new technology using pressure cylinders in order to make the old screw assembly in Kirsten automated.

Applicant asserts that Wallis can only teach one cylinder for moving the knife 12'. It is believed that through the cited case law and through the motivation to provide two pressure cylinders in case of failure of one of the cylinders is old and well known. Manufacturing machines are known to have back-up systems to prevent crippling downtime and thus prevent loss of mass production.

Applicant asserts that there is no suggestion to combine stops such as support members 15 to a device such as the shear knife 12 of Kirsten. It is believed that stops are used in several devices in which there are sliding or moving objects. In Mori the stop is provided to prevent the slider 16 from coming out of the rail 13. In Kirsten, there is possibility that the adjustable post 12 could be adjusted beyond the base 10 and into the travel path of the knife 12'. If the post is in the travel path and the knife is actuated, the knife 12' could come down onto the post 12' and

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damage it. Moreover, the knife 12' may be damaged by colliding with the top of the post 12.

The stops prevent damage to the adjustable post by restricting movement of the adjustable post into the path of the impacting post.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kuchyt, Pearson and Von Arx are cited for similar structure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 703-305-4949. The examiner can normally be reached on Monday thru Friday between 8am and 5pm. If attempts to

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reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302.

Any inquiry of a general nature or relating to the status of this application should be directed to

the receptionist whose telephone number is 703-308-1148.

*DNH*

IH

December 15, 2003

*au*

Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700